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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,991	08/07/2001	Joel L. Sereboff	192390-00053	3893

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EXAMINER

MIGGINS, MICHAEL C

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,991

Applicant(s)

SEREBOFF

Examiner

Michael C. Miggins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 25-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, claims 1-24 in Paper No. 3 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

REJECTIONS WITHDRAWN

2. There are no rejections withdrawn.

REJECTIONS REPEATED

3. The 35 USC 102(b) rejection of claims 1 and 21 as being anticipated by Jordan is repeated for the reasons of record in paper #3, pages 4-5, paragraphs 7-8. The 35 USC 103(a) rejection of claims 4 and 23 as being unpatentable over Jordan is repeated for the reasons of record in paper #3, pages 5-6, paragraphs 9-10. The 35 USC 103(a) rejection of claims 2-3 as being unpatentable over Jordan in view of Courtney is repeated for the reasons of record in paper #3, pages 7-8, paragraph 11. The 35 USC 103(a) of claims 5-6, 11, 13, 15 and 17 as being unpatentable over Jordan in view of Moore is repeated for the reasons of record in paper #3, pages 8-11, paragraph 12. The 35 USC 103(a) rejection of claims 7-10 as being unpatentable over Jordan in view of Moore and further in view of Jensen is repeated for the reasons of record in paper #3, pages 11-12, paragraph 13.

The 35 USC 103(a) rejection of claim 22 as being unpatentable over Jordan in view of Sobel is repeated for the reasons of record in paper #3, pages 12-13, paragraph 14. Applicant has amended claim 22 to include the limitation "... said pleat structured to accommodate percussive expansion along the plane of said enclosure ..." the added limitation is an intended use and has been given little to no patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The 35 USC 103(a) rejection of claim 12 as being unpatentable over Jordan in view of Moore and further in view of Sobel for the reasons of record in paper #3, page 13, paragraph 15. Applicant has amended claims 12 to include the limitation "... said pleat structured to accommodate percussive expansion along the plane of said enclosure ..." the added limitation is an intended use and has been given little to no patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The 35 USC 103(a) rejection of claim 14 as being unpatentable over Jordan in view of Moore and further in view of Weller is repeated for the reasons of record in paper #3, pages 13-14, paragraph 16. The 35 USC 103(a) rejection of claim 24 as

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being unpatentable over Jordan in view of Weller is repeated for the reasons of record in paper #3, pages 14-15, paragraph 17.

Allowable Subject Matter

4. Claims 16 and 18-20 are allowed.

With regards to claims 16 and 18-20, the primary reason for indication of allowable subject matter is applicant's recited structure which includes a plurality of hemispheres wherein said viscous fluid is inside and outside of said hemispheres (claim 16) and wherein said crushable matrix includes a plurality of pyramids wherein said viscous fluid is disposed outside each said pyramid (claim 18) and applicant's recited pyramidal structure which abuts a supporting layer (claim 19) and the pyramidal structure including arms extending from the base of each pyramid to the supporting layer (claim 20). Such structures are novel because the prior art doesn't teach said structures. Moreover said structures are unobvious because one of ordinary skill in the art would not have been motivated to provide said structures to arrive at applicant's claimed invention which is improved in impact resistance.

ANSWERS TO APPLICANT'S ARGUMENTS

5. Applicant's arguments filed 6/30/03 have been fully considered but they are not persuasive.

Applicant's summary of the invention and status of the claims provided in paper #6, pages 3-6 is acknowledged.

Applicant has argued that Jordan does not disclose an enclosure having both a matrix and a fluid disposed therein. Applicant has alleged that the applicable definition of matrix is, "something resembling a mathematical matrix especially in rectangular arrangement of elements into rows and columns" and the foam material disclosed by Jordan is not structured in rectangular arrangement of elements. However, applicant has provided but one of many definitions for the term "matrix". The Merriam Webster's Collegiate Dictionary provides of a definition of matrix which is, "... material in which something is enclosed or embedded ..." and thus Jordan teaches a matrix material since the foam material has a fluid which is enclosed or embedded in the foam. Furthermore, applicant does not recite any structure or arrangement for the matrix material in claim 1. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the structure or arrangement of the matrix) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With regards to the 35 USC 103(a) rejection of claims 4 and 23 as being unpatentable over Jordan, applicant has argued that Jordan teaches away from the invention recited in claims 4 and 23 because Jordan states that, "if a high viscosity, semifluid substance is used, the foam filling may be dispensed with." (column 2, lines 47-48). However, Jordan only states that the foam filling *may* be dispensed with which clearly means that the foam filling can be included or excluded and thus such a

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statement is clearly not a teaching away from the claimed invention. It is the examiner's position, in the absence of unexpected results, that applicant's claimed viscosity is a result effective variable which can be optimized.

With regards to the 35 USC 103(a) rejection of claims 2-3 as being unpatentable over Jordan in view of Courtney, applicant has argued that there is no suggestion to combine and neither reference teaches a matrix submerged in a viscous fluid.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is that the invention of Courtney provides improved impact resistance (Courtney, page 1, see Technical Field section).

Applicant's argument that neither reference teaches a matrix submerged in a viscous fluid is unpersuasive because Jordan teach a matrix material submerged in a viscous fluid as discussed above.

With regards to the 35 USC 103(a) of claims 5-6, 11, 13, 15 and 17 as being unpatentable over Jordan in view of Moore, applicant has argued that Moore and Jordan are not combinable because since the invention of Moore is structured to prevent the entrance of a liquid into the tube.

In response to applicant's argument that Jordan is not combinable with Moore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the instant case, there is nothing which suggests that the tubes of Moore can not be disposed within the fluid of Jordan while keeping the fluid out of the tubes and one would have been motivated to combine Jordan and Moore in order to provide improved impact resistance (Moore, column 1, lines 28-44).

With regards to the 35 USC 103(a) rejection of claims 7-10 as being unpatentable over Jordan in view of Moore and further in view of Jensen, applicant has argued that neither reference teaches an enclosure having both a matrix and a fluid disposed therein and there is no motivation to combine the references.

Applicant's argument that neither reference teaches a matrix submerged in a viscous fluid is unpersuasive because Jordan teach a matrix material submerged in a viscous fluid as discussed above.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is improved impact resistance (Jensen, column 3, lines 54-68).

With regard to the 35 USC 103(a) rejection of claim 22 as being unpatentable over Jordan in view of Sobel and the 35 USC 103(a) rejection of claim 12 as being unpatentable over Jordan in view of Moore and further in view of Sobel, applicant has argued that applicant's amendment to claims 22 and 12 overcome the Sobel reference. Furthermore, applicant has argued that there is no suggestion to combine.

Applicant has amended claims 12 and 22 to include the limitation "... said pleat structured to accommodate percussive expansion along the plane of said enclosure ...". The added limitation is an intended use and has been given little to no patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is improved impact resistance (Sobel, column 1, lines 56-75).

With regard to the 35 USC 103(a) rejection of claim 14 as being unpatentable over Jordan in view of Moore and further in view of Weller and the 35 USC 103(a) rejection of claim 24 as being unpatentable over Jordan in view of Weller, applicant has argued that none of the references teach an enclosure having both a matrix and a fluid disposed therein and there is no motivation to combine the references.

Applicant's argument that neither reference teaches a matrix submerged in a viscous fluid is unpersuasive because Jordan teach a matrix material submerged in a viscous fluid as discussed above.

Conclusion


6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is (703) 305-0915. The examiner can normally be reached on Monday-Friday; 1:30-10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pyon Harold can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

MCM 
October 28, 2003


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

10/29/23